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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,973	06/13/2008	Michel Banatre	017346-0192	8871
22428 7590 01/26/2012 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
DASS, HARISH T				
ART UNIT		PAPER NUMBER		
3695				
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01/26/2012		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/585,973

Applicant(s)

BANATRE ET AL.

Examiner

HARISH T. DASS

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/08/2011 has been entered.

2. **Priority:** Jan 14, 2004.

3. **Status of Claims:**

Claims 1-2, and 4-25 are pending (claim 25 New)

Claim 3 is canceled.

4. **Status of Office Action:** Final

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sebetciouglu et al. (Sebetciouglu - US 5,719,918) in view of Jacobson (US 2003/0004876 A1) and "Ecma International: Ecma welcomes ISO/IEC adoption of NFC Standard for short range wireless communication; Near Field Communications (NFC) protocol establishes instant network connections between devices" M2 Presswire. Coventry: Dec 8, 2003 pg. 1 (hereinafter Presswire) and Foote et al. (hereinafter Foote – US 7,716,133).

Re. Claim 1, Sebetciouglu discloses

- a station capable of carrying out a transaction [Abstract; col. 3 lines 1-7, col. 6 lines 41-46]; and
- an **apparatus** capable of setting up a wireless communication network with one or more mobile terminals, based on a connection protocol, as well as a communication with the station [Figures 1-3, 10 (communication network and mobile terminal) and associated descriptions; col. 5 line 57 through col. 6 line 6 (cellular telephone network; protocols for interfacing SMSC to THS)]; and
- wherein the station is capable, upon presentation of the unique temporary code (IDT), of recovering then completing as required and validating the transaction [col. 14 lines 56-59; col. 15 line 28 through col. 16 line 54];
- Sebetciouglu implicitly discloses wherein the **connection protocol** is configured to allow the initial exchange of an identity information (IDS) transmitted by a mobile terminal present in the **zone in exchange for** a unique temporary code

(IDT) (PIN), such **exchange** being followed by the launch of a background function allowing the preparation of at least part of a transaction on the basis of the identity information (IDS) [Abstract; Figures 2-6, 10, 12 and associated descriptions; col. 1 lines 9-60, col. 3 line 1 through col. 4 line 4 (cellular telephone Network, apparatus, unique code), col. 5 line 57 through col. 6 line 46, col. 15 line 28 through col. 16 line 54];

Sebetciouglu does not explicitly

wherein the **connection protocol** is configured to allow the initial exchange of an identity information (IDS) transmitted by a mobile terminal present in the **zone in exchange for** a unique temporary code, such **exchange** being followed by the launch of a background function allowing the preparation of at least part of a transaction on the basis of the identity information (IDS)

- wherein the apparatus is configured with an adaptable physical perimeter selected to cover a determined zone, close to the station.

However, short-range communication is known, similarly, hand-shaking between to wireless device are known. For example, DC Metro Smartcard transaction.

Presswire discloses wherein the **connection protocol** is configured to allow the initial exchange of an identity information (IDS) transmitted by a mobile terminal present in the **zone in exchange for** a unique temporary code, such **exchange** being followed by the launch of a background function allowing the preparation of at least part of a transaction (data) on the basis of the identity information (IDS). It would have been obvious at the time the invention was made to a person having ordinary skill in the art

motivated to modify the disclosure of Sebetciouglu and include Near Field Communication wireless interface and NFC protocol, as disclosed by Presswire to transmit message between the mobile device and trans-receiver for contactless transaction.

Foote discloses

- wherein the apparatus is configured with an adaptable physical perimeter selected to cover a determined zone, close to the station [Abstract; Figures 2-4, 9; Col. 1 lines 1-32, lines 45-67 ("ATM may be modified ... This enables a user ... Te modifying step may include retrofitting the ATM with a transceiver adapted to receive signals directly from wireless telephone ..", Col. 2 lines 23-40 ("... The transceiver may be operable in two modes ...local wireless communication, such as Bluetooth ... can align his/her wireless telephone ..." – local = zone), Col. 3 lines 53-59, Col. 7 lines 52-53]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art motivated to modify the disclosure of Sebetciouglu and include wherein the apparatus retrofitting with transceiver to allow the user to personalize his/her user interface and directly communicate with transaction device using wireless devices such as: cellular phone without touching the ATM keypad. In this case, the claim would have been obvious to one of ordinary skill in the art capable of applying the known techniques disclosed by Foote (retrofitting ATM with transceiver to communicate using wirelessly or using Bluetooth technology protocol) to a known method short message handling transaction system and financial application of

ATM of Sebetciouglu that was ready for improvement and the result have been predictable to one ordinary skill in the art.

- Claim 25, Presswire discloses wherein the apparatus is configured to reduce the determined zone by reducing the range of the apparatus (close to touch).

Claims 2, and 4-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sebetciouglu and Foote and Presswire as applied to claim 1 above, and further in view of Jacobson.

Re. Claims 2-24, Sebetciouglu discloses

Claim 2

- wherein the station is configured to form part of a wireless communication network of the said apparatus;

Claim 6

- wherein the background function is launched upon receipt of a message or through the communication apparatus;

Claim 7

- wherein the background function is implanted at least in part in the station or in a local network of which the station forms part;

Claim 8

- wherein the background function is implanted at least in part in the apparatus.

Claim 9

- a communication unit capable of allowing a communication with a remote server, and in that the preparation of transaction comprises at least one verification linked to the said identity information (IDS), and carried out by interrogation of the remote server.

Claim 16

- wherein the presentation of the unique temporary code (IDT) to the station is carried out from the mobile terminal.

Claim 17

- wherein the station comprises a verification function capable of comparing the value of the unique temporary code (IDT) presented with a value of the reference unique temporary code (IDT) and whose result is a condition of validation of the transaction [see enter document particularly - Abstract; Figures 2-6, 10, 12 and associated descriptions; col. 1 lines 9-60, col. 3 line 1 through col. 4 line 4 (cellular telephone Network, apparatus, unique code), col. 5 line 57 through col. 6 line 46, col. 15 line 28 through col. 16 line 54].

Jacobson discloses the following limitations not disclosed by Sebetcioğlu or Foote.

Jacobson discloses:

Claims 2, 4

- wherein the apparatus is configured to operate according to a short-range radio communication standard; characterized in that the apparatus is contrived

(configured) to operate according to a short-range radio communication standard;

Claim 5

- wherein the apparatus is configured to operate according to the Bluetooth or NFC standard;

Claim 10

- the non-prepared part of the transaction comprises a financial element, and wherein the interrogation of the remote server comprises a credit verification linked to the identity information (IDS).

Claim 11

- the interrogation of the remote server comprises a credit verification for an amount linked at least in part to a class of transactions carried out by the station and to the identity information (IDS).

Claim 12

- the interrogation of the remote server comprises a credit verification for an amount defined by complementary data established during the initial exchange.

Claim 13

- wherein the transaction comprises a cash withdrawal.

Claim 14

- the transaction is a commercial transaction (inherent).

Claim 15

- the transaction is of the access control type (card controlled).

Claim 18

- the station further comprises an interrogation function configured to set up as the value of the reference unique temporary code (IDT) a value of the unique temporary code (IDT) recorded in a memory of the mobile terminal.

Claim 19

- the station comprises a capture element for presentation of the unique temporary code (IDT).

Claim 20

- the value of the reference unique temporary code (IDT) is transmitted by the mobile terminal.

claim 21

- wherein presentation of the unique temporary code (IDT) to the station is carried out from the mobile terminal through the same wireless communication network.

Claim 22

- a monitor function capable of cancelling a transaction prepared according to a selected expiry criterion (inherent in card authorization - card has expiry date).

Claim 23

- the apparatus is configured to operate according to a short range radio communication standard.

Claim 24

- wherein the interrogation of the remote server comprises a credit verification for an amount defined by complementary data established during the initial exchange [see entire document particularly - Abstract; Figures 4-5; paragraphs 02, 07-08,26, 100-101, 106,110, 121-129, 134,158].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Sebetciouglu & Foote and Presswire and include the above features, as disclosed by Jacobson, to provide a transaction system with wireless device and plurality of bases station using short message service center and mobile terminal for paying for the purchases of goods and service by credit card, where the user is authenticated by the mobile terminal according to the mobile terminal ID, and requesting a user secret code (PIN), from mobile terminal which uses low cost, low interference commercially available communication equipment.

Response to Arguments

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that "Foote discloses a method for updating a self-service terminal ...", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HARISH T. DASS whose telephone number is (571)272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kyle Charles can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/585,973
Art Unit: 3695

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/HARISH T DASS/
Primary Examiner, Art Unit 3695

Wednesday, January 25, 2012